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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steffen Fries

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EXAMINER

WILLIAMS, JEFFERY L

ART UNIT

PAPER NUMBER

2437

MAIL DATE

DELIVERY MODE

07/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/580,954	FRIES, STEFFEN	
	Examiner	Art Unit	
	JEFFERY WILLIAMS	2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 14, 15, 17, 20 – 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 14, 15, 17, 20 – 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the communication filed on 3/19/09.
All objections and rejections not set forth below have been withdrawn.
Claims 11, 14, 15, 17, 20 – 22 are pending.

Claim Objections

Claim 22 is objected to because of the following informalities: The recitation "...a protocol processing unit enabling communication between terminals of ~~the a~~ IP-based Local Area Network..." is grammatically improper. The examiner presumes the applicant to recite "...a protocol processing unit enabling communication between terminals of ~~a~~ IP-based Local Area Network...". Appropriate correction is required.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for the recitation: *a modem connecting **any telecommunication terminal** of the telephone network with the protocol processing unit, to ensure communication between the telecommunication*

*terminal of the telephone network and **any terminal** of the IP-based Local Area Network using the encrypted transport protocol.*

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitations in the application as filed (see above objection to the specification).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2437

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 14, 15, 17, 20 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiSanto et al. (DiSanto), U.S. Patent Publication 2003/0009659 in view of Blom et al. (Blom), “Conversational IP Multimedia Security”.

Regarding claim 11, DiSanto discloses:

a protocol processing unit processing messages of the key exchange protocol as well as data packets transported using the encrypted transport protocol, converting voice signals, created by the one of the first and second telecommunication terminals at which said security module is connected, into data packets for transport via the encrypted transport protocol and converting data packets, arriving at said security module after transport via the encrypted transport protocol, into voice signals (DiSanto, fig. 2b:210,220; par. 31, 42, 43 – Herein DiSanto discloses means for processing key exchange and encrypted data transport procedures [i.e. "protocols"] for the purpose of encrypting and decrypting voice and data communications between telecommunication terminals);

a modem connection unit, used when said security module is connected in a connecting line at a second telecommunication terminal, setting up a modem connection between the second telecommunication terminal and at least one of the gateway and another second telecommunication terminal, with the data packets being

1 *transported using the encrypted transport protocol, along with messages of the key*
2 *exchange protocol, via the modem connection (DiSanto, fig. 2b:240; fig. 4; par. 33).*

3 *wherein a point-to-point protocol connection is used over the modem connection*
4 *in transporting the data packets using the encrypted transport protocol, as well as*
5 *messages of the key exchange protocol (DiSanto, par. 41, 42 – herein DiSanto*
6 *discloses a procedure for establishing a direct connection between two nodes [i.e.*
7 *“point-to-point protocol connection”].*

8 DiSanto discloses a security module designed to provide encrypted transport to
9 data between terminals within a network. DiSanto, however, does not appear to
10 explicitly recite *wherein the encrypted transport protocol is Secure Real Time Transport*
11 *Protocol.*

12 Blom discloses that applications for securely transmitting voice data through
13 networks, such as disclosed by DiSanto, should employ SRTP (Blom, Abstract). It
14 would have been obvious to one of ordinary skill in the art to employ the teachings of
15 Blom within DiSanto. This would have been obvious because one of ordinary skill in the
16 art would have been motivated by the teachings that such security protocols and
17 methods were designed specifically so as to improve the secure transport of voice and
18 data between communication terminals (Blom, Abstract; section 3).

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20 Regarding claim 14, the combination enables:

21 *wherein the key exchange protocol is multimedia Internet keying (Blom,*
22 *Abstract).*

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Regarding claim 15, the combination enables:

wherein for a telephone conversation, messages of the key exchange protocol are transported via a session initiation protocol, and wherein said protocol processing unit processes the session initiation protocol (Blom, section 2; section 5).

Regarding claim 17, the combination discloses that any conventional communications system may be employed (DiSanto, par. 19). While the combination does not appear to explicitly recite an ISDN communications system or the utilization of the B channel of the ISDN system, the examiner notes that the employment of ISDN and the B channel of ISDN were well known and implemented concepts to those of ordinary skill in the art. One of ordinary skill in the art would have been motivated to recognize ISDN and the utilization of communications over the B channel because such system was conventional and its benefits were well recognized.

Regarding claim 20, the combination enables:

wherein the packet-oriented network is an Internet protocol-based data network, wherein the packet-oriented network is local area network (DiSanto, par. 19), and said modem connection unit sets up the modem connection in accordance with at least one of a V90 and a V92 standard (DiSanto, par. 33).

Regarding claim 21, the combination enables:

wherein said security module is connected into a connecting cable between a telephone handset and the one of the first and second telecommunication terminals (DiSanto, fig. 1).

Regarding claim 22, it comprises essentially similar recitations as claim 11, and it is rejected, at least, for the same reasons as claim 11. Furthermore, the combination enables:

a modem connecting any telecommunication terminal of the telephone network with the protocol processing unit (Abstract; fig. 2b; fig. 4; par. 33), to ensure communication between the telecommunication terminal of the telephone network and any terminal of the IP-based Local Area Network using the encrypted transport protocol.

Response to Arguments

Applicant's arguments filed 3/19/09 have been fully considered but they are not persuasive.

Applicant argues or asserts essentially that:

Amended independent claim 1 patentably distinguishes over DiSanto at least by reciting "a modem connection unit, used when said security module is connected in a connecting line at a second telecommunication terminal, setting up a modem

1 connection between the second telecommunication terminal and at least one of the
2 gateway and another second telecommunication terminal." Applicants respectfully direct
3 the Examiner's attention to the fact that the claimed modem unit achieves a transfer of
4 encryption technologies from the packet oriented network into public telephone network.

5 ...Thus, the modem 240 is used merely to comply with the technical
6 requirements of a respective network, but not to provide a technical solution enabling
7 encryption of voice data in a heterogeneous network including a packet oriented
8 network and a telephone network. (Remarks, pg. 5)

9
10 *Examiner responds:*

11 Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount
12 to a general allegation that the claims define a patentable invention without specifically
13 pointing out how the language of the claims patentably distinguishes them from the
14 references.

15 The examiner notes that the prior art clearly discloses "a modem connection unit,
16 used when said security module is connected in a connecting line at a second
17 telecommunication terminal, setting up a modem connection between the second
18 telecommunication terminal and at least one of the gateway and another second
19 telecommunication terminal" (DiSanto, fig. 2b:240; fig. 4; par. 33).

20 In response to applicant's argument that the references fail to show certain
21 features of applicant's invention, it is noted that the features upon which applicant relies
22 (i.e., "the fact that the claimed modem unit achieves a transfer of encryption

1 technologies from the packet oriented network into public telephone network” and
2 “provide a technical solution enabling encryption of voice data in a heterogeneous
3 network including a packet oriented network and a telephone network”) are not recited
4 in the rejected claim(s). Although the claims are interpreted in light of the specification,
5 limitations from the specification are not read into the claims. See *In re Van Geuns*, 988
6 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7
8 *Applicant argues or asserts essentially that:*

9 Furthermore, amended claim 1 now specifies that "a point-to-point protocol
10 connection is used over the modem connection in transporting the data packets using
11 the encrypted transport protocol, as well as messages of the key exchange protocol."
12 The Office Action alleges that this feature originally recited in claim 12, is anticipated by
13 "a procedure for establishing a direct connection between two nodes" disclosed in
14 DiSanto. However, unlike in DiSanto, the modem of the claimed security module
15 enables a "telephone conversation between at least one first telecommunication
16 terminal using a Voice over IP (VoIP) system in a packet-oriented data network, and at
17 least one second telecommunication terminal in a telephone network." The procedure
18 for establishing a direct connection between two nodes in DiSanto does not anticipate
19 or render obvious this type of connection among terminals of different networks.

20 (Remarks, pg. 5, 6)

21
22 *Examiner responds:*

1 First, it is respectfully noted that the applicant's remarks appear to focus solely
2 on the disclosed modem of the prior art and ignores the full disclosure of the prior art
3 enabling the claimed "security module". For this reason, the examiner notes that the
4 applicant's assertions do not appear persuasive.

5 Second, the examiner notes that the applicant's assertion, "*The procedure for*
6 *establishing a direct connection between two nodes in DiSanto does not anticipate or*
7 *render obvious **this type of connection among terminals of different networks***"
8 does not serve to clearly point out how the recited claim language is distinguished from
9 the prior art. The examiner reminds the applicant that the claim does not recite a
10 procedure or method, but instead recites an "security module" apparatus comprising
11 "protocol processing unit" and a "modem connection unit". The applicant's remarks do
12 not appear to address the limiting features of the apparatus and appear to only pertain
13 to features relative to the intended use of the apparatus. The examiner respectfully
14 reminds the applicant that a claim containing a "recitation with respect to the manner in
15 which a claimed apparatus is intended to be employed does not differentiate the
16 claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the
17 structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. &
18 Inter. 1987). Thus, in response to applicant's argument that the prior art *does not*
19 *anticipate or render obvious **this type of connection among terminals of different***
20 ***networks***", a recitation pertaining to the intended use of the claimed invention must
21 result in a structural difference between the claimed invention and the prior art in order

1 to patentably distinguish the claimed invention from the prior art. If the prior art
2 structure is capable of performing the intended use, then it meets the claim.

3 Finally, the examiner notes in response to applicant's arguments, the recitation
4 "a security module for encrypting a telephone conversation between at least one first
5 telecommunication terminal using a Voice over IP (VoIP) system in a packet-oriented
6 data network, and at least one second telecommunication terminal in a telephone
7 network" is not given patentable weight because the recitation occurs in the preamble.

8 A preamble is generally not accorded any patentable weight where it merely recites the
9 purpose of a process or the intended use of a structure, and where the body of the
10 claim does not depend on the preamble for completeness but, instead, the process
11 steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190
12 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481
13 (CCPA 1951).

14
15 *Applicant argues or asserts essentially that:*

16 However, the Office Action does not consider the claim as a whole, including the
17 preamble, which specifies that the security module is used "for encrypting a telephone
18 conversation between at least one first telecommunication terminal using a Voice over
19 IP (VoIP) system in a packet-oriented data network, and at least one second
20 telecommunication terminal in a telephone network that is at least one of analog and
21 digital and is connected to the packet-oriented network via a gateway." Thus, the
22 encrypted transport protocol being Secure Real Time Transport Protocol in such a

1 heterogeneous network and the features of security module are not rendered obvious
2 merely by the above-reproduced statement which is a prior art recommendation in
3 vacuum, with no relation to the environment in which the claimed secured module
4 functions. (Remarks, pg. 6)

5
6 *Examiner responds:*

7 In response, the examiner respectfully notes that the applicant fails to provide
8 any argument or clearly presented evidence supporting the allegation that the claims
9 were not properly considered as a whole. As such, the applicant's arguments do not
10 appear persuasive.

11 Furthermore, as previously noted, the applicant's remarks do not appear to
12 address the limiting features of the apparatus and appear to only pertain to features
13 relative to the intended use of the apparatus. The examiner respectfully reminds the
14 applicant that a claim containing a "recitation with respect to the manner in which a
15 claimed apparatus is intended to be employed does not differentiate the claimed
16 apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural
17 limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter.
18 1987). A recitation pertaining to the intended use of the claimed invention must result in
19 a structural difference between the claimed invention and the prior art in order to
20 patentably distinguish the claimed invention from the prior art. If the prior art structure is
21 capable of performing the intended use, then it meets the claim.

1 Finally, the examiner notes in response to applicant's arguments, the recitation
2 "a security module for encrypting a telephone conversation between at least one first
3 telecommunication terminal using a Voice over IP (VoIP) system in a packet-oriented
4 data network, and at least one second telecommunication terminal in a telephone
5 network" is not given patentable weight because the recitation occurs in the preamble.
6 A preamble is generally not accorded any patentable weight where it merely recites the
7 purpose of a process or the intended use of a structure, and where the body of the
8 claim does not depend on the preamble for completeness but, instead, the process
9 steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190
10 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481
11 (CCPA 1951).

12
13 ***Conclusion***
14

15 The prior art made of record and not relied upon is considered pertinent to
16 applicant's disclosure:

17 ***See Notice of References Cited.***
18

19 Applicant's amendment necessitated the new ground(s) of rejection presented in
20 this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
21 § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
22 CFR 1.136(a).

1 A shortened statutory period for reply to this final action is set to expire THREE
2 MONTHS from the mailing date of this action. In the event a first reply is filed within
3 TWO MONTHS of the mailing date of this final action and the advisory action is not
4 mailed until after the end of the THREE-MONTH shortened statutory period, then the
5 shortened statutory period will expire on the date the advisory action is mailed, and any
6 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
7 the advisory action. In no event, however, will the statutory period for reply expire later
8 than SIX MONTHS from the date of this final action.

9 Any inquiry concerning this communication or earlier communications from the
10 examiner should be directed to Jeffery Williams whose telephone number is (571) 272-
11 7965. The examiner can normally be reached on 8:30-5:00.

12 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
13 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone
14 number for the organization where this application or proceeding is assigned is (703)
15 872-9306.

16 Information regarding the status of an application may be obtained from the
17 Patent Application Information Retrieval (PAIR) system. Status information for
18 published applications may be obtained from either Private PAIR or Public PAIR.
19 Status information for unpublished applications is available through Private PAIR only.
20 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
21 you have questions on access to the Private PAIR system, contact the Electronic
22 Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2437

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3 /Jeffery Williams/

4 Examiner, Art Unit 2437

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6 /Emmanuel L. Moise/

7 Supervisory Patent Examiner, Art Unit 2437

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